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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,405	07/03/2003	Faith M. Oi	FLG-023DIV	4475

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EXAMINER

VALENTI, ANDREA M

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,405

Applicant(s)

OI ET AL.

Examiner

Andrea M. Valenti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

The abstract of the disclosure is objected to because it exceeds the required length. Correction is required. See MPEP § 608.01(b).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,637,150; claims 1-28 of U.S. Patent No. 6,298,597 B1; claims 1-34 of U.S. Patent No. 6,606,816 B2; and claims 1-34 of U.S. Patent No. 6,606,817 B2.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because they all teach a method of killing arthropods using a chamber with a non-toxic food source, a non-edible toxicant matrix, and allowing the arthropods to exit the chamber and return to their colonies.

Claims 43-61 provisionally rejected under the judicially created doctrine of double patenting over claims 1-38 of copending Application No. 10/098,017 and claims 1-33 of copending Application No. 10/097,813. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: they all teach a method of killing arthropods using a chamber with a non-toxic food source, a non-edible toxicant matrix, and allowing the arthropods to exit the chamber and return to their colonies.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 45 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 45 and 55 contains the trademark/trade name Styrofoam. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an expanded rigid polystyrene plastic and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43-47 and 49-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,979,108 to Adams in view of U.S. Patent No. 5,555,672 to Thorne.

Regarding Claims 43, 50, 54 and 56, Adams teaches a composition and method for treating different arthropods with an alternating layers of mixture layer of a non-edible foraging matrix mixed with a slow acting toxicant (Adams #4 and Col. 3 line 21), and a non-toxic layer (Adams #7), and a non-toxic attractant material, wherein arthropods can be treated over time (Adams Col. 1 line 3-5).

Adams is silent on the non-toxic layer selected from at least one of: an edible non-toxic material. However, Thorne teaches that it is traditional practice in the art of pest management to use a food source as a bait (Thorne Fig. 5b and Col. 10 line 58-59). It would have been obvious to one of ordinary skill in the art to modify the teachings of Adams with the teachings of Thorne since the baits are merely alternate equivalent attractants selected for different economic parameters.

Regarding Claim 44, Adams as modified teaches the non-toxic layer includes cellulose (Thorne Fig. 5b).

Regarding Claims 45 and 55, Adams as modified teaches the non-toxic layer includes at least one of foam and Styrofoam (Adams Col. 5 line 5).

Regarding Claim 46, Adams as modified teaches an outer covering (Adams #1) to contain the alternating layers, the outer casing for allowing the alternating layers to be placed under ground (Thorne abstract), wherein the outer covering will allow arthropods to access the alternating layers.

Regarding Claim 47, Adams as modified teaches the arthropods include different arthropods (Adams Col. 1 lines 3-5).

Regarding Claim 49, Adams as modified teaches a first layer being the mixture layer of the non-edible foraging matrix mixed with the slow-acting toxicant that the arthropods initially pass through (Adams Fig. 1b #4 and 5).

Regarding Claim 51 and 61, Adams as modified teaches inserting the alternating layers into a chamber having at least one entrance for the crawling arthropods (Adams Fig. 1b)

Regarding Claims 52, 53, 59, and 60, Adams as modified teaches treating different arthropods with the alternating layers and the different arthropods are selected from at least one of termites, carpenter ants, fire ants, and roaches (Adams Col. 1 line 3-5).

Regarding Claim 57, Adams as modified teaches an alternating layer of the foraging non-edible matrix mixed with the slow acting and non-repellant toxicant against another side of the second layer (Fig. 1a #7 and #5)

Regarding Claim 58, Adams as modified teaches an alternating layer of the non-toxic material against another side of the first layer (Adams Fig. 1b #7 and #5).

Claims 43, 44, 46-54, and 56-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,219,961 B1 to Ballard.

Regarding Claims 43, 50, 54 and 56-59, Ballard teaches a composition and method for treating different arthropods (Ballard Abstract) with layers of mixture layer of a non-edible foraging matrix mixed with a slow acting toxicant, and a non-toxic layer, the non-toxic layer selected from at least one of: an edible non-toxic material, and a non-

toxic attractant material, wherein arthropods can be treated over time (Ballard Col. 3 line 66-67 and line 52-53). Ballard teaches alternating compartments containing a matrix (Ballard Fig. 4 #130 and #112), but is silent on explicitly teaching alternating layer of edible foraging matrix and non-edible foraging matrix with toxicant. However, Thorne teaches that it is old and notoriously well known to attract arthropods using an edible foraging matrix (Thorne #70). It would have been obvious to modify Ballard with the teachings of Thorne at the time of the invention since the modification is merely the selection of an known alternate foraging matrix used to establish a high attraction level to the device from the arthropods.

Regarding Claim 44, Ballard as modified teaches the non-toxic layer includes cellulose (Thorne #70).

Regarding Claim 46, Ballard as modified teaches an outer covering (Ballard #104) to contain the alternating layers, the outer casing for allowing the alternating layers to be placed under ground (Thorne abstract), wherein the outer covering will allow arthropods to access the alternating layers.

Regarding Claim 47, Ballard as modified teaches the arthropods include different arthropods (Ballard abstract).

Regarding Claims 48 and 49, Ballard as modified is silent on the first layer being the non-toxic layer that the arthropods initially pass through or the first layer being the mixture layer of the non-edible foraging matrix mixed with the slow-acting toxicant that the arthropods initially pass through. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings through

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routine tests and laboratory experimentation to arrive at the most effective/efficient combination.

Regarding Claims 51 and 61, Ballard as modified teaches inserting the alternating layers into a chamber having at least one entrance for the crawling arthropods (Ballard #144 and 116).

Regarding Claims 52, 53, and 60, Ballard as modified teaches treating different arthropods with the alternating layers and the different arthropods are selected from at least one of termites, carpenter ants, fire ants, and roaches (Ballard abstract and Col. 1 line 6).

Claims 45 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,219,961 to Ballard as applied to claim 43 above, and further in view of U.S. Patent No. 3,972,993 to Kobayashi et al.

Regarding Claims 45 and 55, Ballard as modified is silent on the non-toxic layer includes at least one of foam and Styrofoam. However, Kobayashi et al teaches that foam is an alternate equivalent to cellulose (Kobayashi 3 line 40). It would have been obvious to one of ordinary skill in the art to modify the teachings at the time of the invention since the modification is merely an engineering design choice of a selection of an alternate equivalent material to meet certain design cost parameters.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Japanese Patent JP 56151759.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea M. Valenti whose telephone number is 703-305-3010. The examiner can normally be reached on 7:30am-5pm M-F; Alternating Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 703-308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Andrea M. Valenti
Examiner
Art Unit 3643

25 March 2004



Peter M. Poon
Supervisory Patent Examiner
Technology Center 3600